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EXAMINER

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ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/290,251

Applicant(s)

Nagal et al.

Examiner  
Nicholas D. Rosen

Group Art Unit  
2165



☒ Responsive to communication(s) filed on Oct 31, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Claims 1-16 have been examined.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying permission on a signal of digitized video data and/or a signal of audio data or embedding the information therein (Abstract; see also column 1,

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lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying permission superimposed on or embedded in the video data and/or audio data (column 18, lines 12-41); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying permission

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superimposed on or embedded in the video data and/or audio data (column 18, lines 12-41); an error correction unit which conducts error correction according to an added correction code (column 14, lines 46-51; note also column 13, lines 51-57); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose destroying data, as opposed to merely stopping reproduction. However, if reproduction is stopped, then the data being played from the medium to be reproduced are destroyed, since data which are not being reproduced anywhere are destroyed. The original data on the medium to be reproduced are not destroyed in the system of Tozaki et al., but neither does the instant application disclose destroying the original copies of such data.

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6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Claim 3 largely recites the same limitations as claim 2, and is therefore rejected on the same grounds. Claim 3 additionally recites that the destroying unit destroys data so as to make error detection of data not yet subjected to error correction processing possible and make error correction thereof impossible to certain indications. Tozaki et al. do not expressly disclose these limitations. However, when data is destroyed, error correction thereof becomes impossible; when data is not destroyed, error detection and correction by well-known techniques, as disclosed in Tozaki et al., may remain possible. Hence, the apparatus of claim 3 is held not to differ substantially from that of claim 2.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27); and an output unit which outputs data representing a reason of stoppage (column 21, lines 14-27). Tozaki et al. do not

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disclose an identifying unit which identifies whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include an identifying unit which identifies whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose that the means for notifying a user of the reason for stoppage outputs video data and/or audio data. However, official notice is taken that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output the notification as video data and/or audio data, for the obvious advantage of conveniently conveying the notification information.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or

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a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); an error correction unit which conducts error correction according to an added correction code (column 14, lines 46-51; note also column 13, lines 51-57); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose an identifying unit which identifies whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose destroying data, as opposed to merely stopping reproduction. However, if reproduction is stopped, then the data being played from the medium to be reproduced are destroyed, since data which are not being reproduced anywhere are destroyed. The original data on the medium to be reproduced are not destroyed in the system of



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Tozaki et al., but neither does the instant application disclose destroying the original copies of such data.

b. Tozaki et al. do not expressly disclose that the destroying unit destroys data so as to make error detection of data not yet subjected to error correction processing possible and make error correction thereof impossible to certain indications. However, when data is destroyed, error correction thereof becomes impossible; when data is not destroyed, error detection and correction by well-known techniques, as disclosed in Tozaki et al., may remain possible.

c. Tozaki et al. do not expressly disclose that the means for notifying a user of the reason for stoppage outputs video data and/or audio data. However, official notice is taken that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output the notification as video data and/or audio data, for the obvious advantage of conveniently conveying the notification information.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus

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comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose that the means for notifying a user of the reason for stoppage outputs a control signal, the control signal instructing a video signal and/or audio signal representing a reason of stoppage to be outputted. However, official notice is taken that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output a control signal instructing a video signal

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and/or audio signal representing a reason of stoppage to be outputted, for the obvious advantage of conveniently conveying the notification information.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); an error correction unit which conducts error correction according to an added correction code (column 14, lines 46-51; note also column 13, lines 51-57); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium

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is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose destroying data, as opposed to merely stopping reproduction. However, if reproduction is stopped, then the data being played from the medium to be reproduced are destroyed, since data which are not being reproduced anywhere are destroyed. The original data on the medium to be reproduced are not destroyed in the system of Tozaki et al., but neither does the instant application disclose destroying the original copies of such data.

b. Tozaki et al. do not expressly disclose that the destroying unit destroys data so as to make error detection of data not yet subjected to error correction processing possible and make error correction thereof impossible to certain indications. However, when data is destroyed, error correction thereof becomes impossible; when data is not destroyed, error detection and correction by well-known techniques, as disclosed in Tozaki et al., may remain possible.

c. Tozaki et al. do not expressly disclose an output unit which outputs a control signal instructing video data and/or audio data representing a reason why reproduction is impossible to be outputted. However, official notice is taken that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to

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output the notification as video data and/or audio data, for the obvious advantage of conveniently conveying the notification information.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Takemura et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a permission information reproduction circuit reproducing the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a reproduction stopping circuit stopping reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not expressly disclose a medium identification code detection circuit detecting the medium identification code, but Takemura et al. teach detecting a medium identification code (column 9, lines 14-20). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a medium identification code detecting circuit detecting the medium identification code, and to stop reproduction in response to a medium identifying code indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

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12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. and Takemura et al. as applied to claim 8 above. Tozaki does not disclose integrating a medium identification detecting circuit and a reproduction stopping circuit into a single semiconductor device, but official notice is taken that it is well known to integrate a multiplicity of circuits into a single semiconductor device (as witness the terms “integrated circuit” and “computer on a chip”). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant’s invention to integrate these several circuits into a single semiconductor device, for the obvious advantages of simplifying chip manufacture, not needing to connect a multiplicity of chips to one another, and enhanced security, in that signals within a single chip cannot be as readily detected and falsified as signals between separate chips or other arrangements of circuit elements.

13. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Doi. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data or a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproduction unit for reproducing the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit for stopping reproduction in response to the information reproduced by the reproduction unit

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indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a detection unit for detecting reflectance of a disk, or a determining unit for determining whether the disk is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, but Doi teaches determining whether a disk is dedicated to reproduction or recording, based on the reflectance of the disk (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a detection unit for detecting reflectance of a disk, and a determining unit which determines whether a disk is a recordable medium or a medium dedicated to reproduction, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Doi and of Takemura et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproduction unit for reproducing the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit for stopping reproduction in response to the information reproduced

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by the reproduction unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a reflectance detection unit for detecting reflectance of a disk, or a determining unit for determining whether the disk is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, but Doi teaches determining whether a disk is dedicated to reproduction or recording, based on the reflectance of the disk (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a reflectance detection unit for detecting reflectance of a disk, and a determining unit which determines whether a disk is a recordable medium or a medium dedicated to reproduction, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose an identification detection unit for detecting the medium identification code, but Takemura et al. teach detecting a medium identification code (column 9, lines 14-20). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include an identification code detecting unit for detecting the medium identification code, and to stop reproduction in response to a medium identifying code indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

15. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Yokota et al., and of Fox. Tozaki et al. disclose a reproduction apparatus for



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reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproduction unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit which stops reproduction in response to the information reproduced by the reproduction unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a wobble detection unit for detecting wobbled grooves existing on a disk, but Yokota et al. teach such a wobble detection unit (column 3, lines 43-55). Furthermore, Fox explicitly teaches preventing piracy by a system which rejects disks for copying if they lack wobbled grooves (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a wobble detection unit for detecting wobbled grooves, and to stop reproduction if the wobble detecting unit does not detect wobbled grooves, for the obvious advantage of limiting the reproduction of proprietary information.

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Yokota et al., Fox, and Takemura et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or

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audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproduction unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit which stops reproduction in response to the information reproduced by the reproduction unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a wobble detection unit for detecting wobbled grooves existing on a disk, but Yokota et al. teach such a wobble detection unit (column 3, lines 43-55). Furthermore, Fox explicitly teaches preventing piracy by a system which rejects disks for copying if they lack wobbled grooves (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a wobble detection unit for detecting wobbled grooves, and to stop reproduction if the wobble detecting unit does not detect wobbled grooves, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose an identification unit for detecting the medium identification code, but Takemura et al. teach detecting a medium identification code (column 9, lines 14-20). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include an identification code detecting unit for detecting the medium identification code, and to stop reproduction in response to a medium

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identifying code indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

17. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Claim 14 recites a method of doing what claim 1 recites apparatus for doing; therefore, claim 14 is rejected on the same grounds as claim 1. (Examiner does not believe the distinction between permission and consent to be of any importance in this context.)

18. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Claim 15 recites a method of doing what claim 2 recites apparatus for doing; therefore, claim 15 is rejected on the same grounds as claim 2. A slight complication is that claim 15 additionally recites "simultaneously judging error correction to be impossible," which claim 2 does not. However, if data is being destroyed altogether, as recited in claims 2 and 15, error correction is held to be inherently impossible, or at least pointless. One cannot correct data which does not exist.

19. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Claim 16 recites a program for doing what claim 1 recites apparatus for doing; therefore, claim 16 is rejected on the same grounds as claim 1. (Examiner does not believe the distinction between permission and consent to be of any importance in this context.)

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*Response to Arguments*

20. Applicants' arguments filed October 31, 2000, have been fully considered but they are not persuasive. At the outset, Applicants note that the present invention is directed to a reproduction method and apparatus for prohibiting reproduction of video and/or audio data recorded in a medium where such reproduction should not be permitted, even though the information indicates that one time information is permitted. Examiner responds that each of the independent claims in fact recites information "indicating that copying once was permitted," and that Tozaki, the primary reference, describes the use of a Serial Copy Management System (SCMS) in which a particular copy flag, 01, indicates that a digital audio tape may be copied once and only once; after copying, the copy flag becomes 00, indicating that copying is forbidden, although it was permitted once. Applicants point out that each independent claim and dependent claim of 1-11 and 14-16 also recites a second factor, that the medium to be reproduced is a medium dedicated to reproduction. Examiner observes that Tozaki refers to DVD's and other media which can be dedicated to reproduction. Applicants note that independent claims 12 and 13 utilize a different second or third factor relating to detection of wobbled grooves. Examiner does not believe that this limitation makes the claims patentable, in view of the teachings of Yokota and Fox. Applicants argue that the cited art taken alone or in any combination fails to disclose or teach the claimed features; Examiner remains convinced that all claimed features are found in the cited prior art. Applicants argue that the rejections as set forth by the Examiner only come about by way of [impermissible] hindsight reconstruction; Examiner disagrees.

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21. In response to Applicants' argument that Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In particular, Applicants quote Tozaki, column 21, lines 14-27, and argue that in accordance with Tozaki, an indication of copy only once is copy-permitted information, and only when the copy flag is set from the copy only once information to copy prohibited information is the copying prohibited. That is certainly true, but after copying has been performed, the copy flag in the system described by Tozaki is set to copying prohibited, and then the system of Tozaki does stop reproduction.

Applicants further argue that Tozaki provides no disclosure of an additional factor relating to the type of the medium, e.g., a medium dedicated to reproduction or a medium with wobbled grooves, as being a factor in determining whether or not reproduction is prohibited or enabled. Examiner agrees that Tozaki does not teach using the presence or absence of wobbled grooves as such a factor, but reminds Applicants that claims 12 and 13 were rejected as obvious over Tozaki in view of other art, not as anticipated by Tozaki. "Dedicated to reproduction" is a slightly ambiguous phrase, in that it leaves unanswered who does the dedicating. A DVD or DAT is a

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medium which can be dedicated to reproduction by persons who wish to reproduce what's on it. A DVD or DAT with an SCMS copy flag of 01 (copy permitted only once) or, still more, 11 (copy permitted) is a medium which has been dedicated to reproduction by the person or persons who set the flag, and Tozaki does disclose the use of such a copy flag as a factor in determining whether or not reproduction is prohibited or enabled.

With regard to Omi, the secondary reference against a number of Applicants' claims, Applicants argue that Omi does not disclose or teach the stopping of reproduction based upon a determination that the disk medium is a medium dedicated to reproduction, which is true, but Examiner did not allege that such a teaching was found in Omi. Omi does teach determining whether a whether a disk medium is a medium dedicated to reproduction, and Examiner combined this teaching with those of Tozaki to conclude that a number of Applicants' claim were obvious. Applicants further argue that the other secondary and tertiary references fail to overcome the deficiencies of Tozaki, since they do not relate to determining of an authorized copy based upon a plurality of factors. Even if the prior art of record does not show this, Examiner remains unconvinced that making such a determination based upon a plurality of factors is nonobvious, when it is known to make a determination based upon any one of the factors.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation is provided by the desire of businesses producing audio and/or visual entertainment not to lose sales due to unauthorized copying. Given that it is known to wear suspenders, and known to wear a belt, wearing suspenders and a belt could plausibly be considered obvious, for the advantage of greater security, particularly if it were documented that millions of dollars depended on people's success in keeping their pants up. Security against unauthorized copying, with the consequent loss of revenue, has for some time been a major concern of the music and movie industries, as is taught, for example, by Parker, Johnstone, and Starrett; therefore, using several known techniques for preventing such copying would have been obvious to one of ordinary skill in the art of copy protection at the time of Applicants' invention.

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maeda et al. (U.S. Patent 6,072,759) disclose a recording medium with format for preventing unauthorized copying, and reproducing apparatus for the same. Bersson (U.S. Patent 6,081,897) discloses apparatus for monitoring and preventing unauthorized copying of digital data. Kanota et al. (U.S. Reissued Patent 36763) disclose an apparatus and method for preventing unauthorized copying of video signals. Otsuka (U.S. Patent 6,094,723) discloses a copy protection system for recording media. Kamatakis et al. (U.S. Patent 6,101,476) disclose a

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CD-ROM software protection system. Whitcher et al. (U.S. Patent 6,104,686) disclose copy protection marks on a transparent layer of an optical disk indicating that the disk has been previously accessed. Tahara et al. (U.S. Patent 6,115,533) disclose a digital video copy protection system.

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be addressed to Nicholas D. Rosen, whose telephone number is (703) 305-0753. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (703) 305-9768. The fax number for this Group is (703) 308-1396.



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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to Nicholas.Rosen@uspto.gov.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 305-3900.



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

*Nicholas D. Rosen*  
Nicholas D. Rosen

January 11, 2001